

Attorney Docket No.: DEX-0205
Inventors: Pluta et al.
Serial No.: 09/823,101
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specification requiring 95% identity for stringent hybridization were found unpersuasive as the Examiner suggests that the claims are broadly drawn to any nucleic acid that hybridizes (completely or partially) to the claimed antisense sequence.

Accordingly, in an earnest effort to advance the prosecution of this case and to clearly distinguish the present invention from the teachings of Kato et al. Applicants have amended claim 1(b) to state that the nucleic acid sequence has at least 95% identity with an antisense sequence of SEQ ID NO: 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12 or 13. Support for this amendment can be found in the specification at page 16, lines 27-30. Since Kato et al. does not teach a nucleic acid sequence with 95% identity as claimed, this reference cannot anticipate the claimed invention.

Withdrawal of this rejection under 35 U.S.C. § 102(b) is therefore respectfully requested.

**II. Rejection of Claims under 35 U.S.C. § 112, first paragraph -
Lack of Enablement**

Claim 9, as it reads on SEQ ID NO:2, has been rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which

Amended

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it is most nearly connected, to make and/or use the invention. Specifically, the Examiner suggests that the specification does not give guidance or exemplification of how SEQ ID NO:2 may be used to diagnose stomach cancer when it is expressed in other tissue types.

Applicants respectfully traverse this rejection as data provided in the specification at pages 57-58 are clearly demonstrative of increased expression of SEQ ID NO:2 being measurable in stomach cancer.

However, in an earnest effort to advance the prosecution of this case, Applicants have canceled claim 9, thus mooting this rejection. Withdrawal of this rejection under 35 U.S.C. § 112, first paragraph, is therefore respectfully requested.

III. Rejection of Claims 1, 3-6 and 9 under 35 U.S.C. § 112, first paragraph - Written Description

Claims 1, 3-6 and 9 have been rejected under 35 U.S.C. § 112 first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner suggests that the instant disclosure of a single species of nucleic acid does not

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adequately describe the scope of the claimed genus, which encompasses a substantial variety of subgenera including full-length genes.

Accordingly, in an earnest effort to advance the prosecution of this case, Applicants have amended claim 1 to be drawn to an isolated polynucleotide comprising SEQ ID NO: 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12 or 13 or a nucleic acid sequence having at least 95% identity with an antisense sequence of SEQ ID NO: 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12 or 13. Applicants believe that these amendments, which are clearly supported by the specification, set forth definitive structural features of the claimed polynucleotides so that one of skill in the art can predictably identify the encompassed molecules as being identical to those now claimed. Further, the claims as amended describe distinguishing identifying characteristics sufficient to show that applicant was in possession of the claimed invention. See MPEP § 2163.02. Thus, the claims as amended meet the written description requirements of 35 U.S.C. § 112, first paragraph.

Withdrawal of this rejection is therefore respectfully requested.

IV. Conclusion

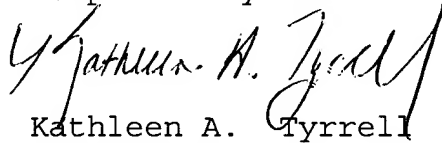
Applicants believe that the foregoing comprises a full and

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complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned **"VERSION WITH MARKINGS TO SHOW CHANGES MADE."**

Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Please cancel claim 9, without prejudice.

Please amend the claims as follows:

1. (amended) An isolated polynucleotide comprising:
 - (a) SEQ ID NO: 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12 or 13; or
 - (b) a nucleic acid sequence ~~which hybridizes under stringent conditions to~~ having at least 95% identity with an antisense sequence of SEQ ID NO: 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12 or 13.